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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARSTEN KRISCHKER,
MARKUS SCHLOZER and ANDREAS TENNERT

Appeal 2008-0739
Application 10/517,935¹
Technology Center 2600

Decided: July 14, 2008

Before ROBERT E. NAPPI, SCOTT R. BOALICK,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ The real party in interest is Siemens Aktiengesellschaft.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 22-25, 27, 29-33, 35, and 37-40.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to identifying a telecommunications subscriber.

Claim 22 is exemplary:

22. A method for identifying a telecommunications subscriber, the method comprising:

signaling a call from a second telecommunications device of a second telecommunications subscriber to a first telecommunications device of a first telecommunications subscriber;

sending device information from the first telecommunications device to the second telecommunications device which indicates a type of subscriber data that the first telecommunication device wants to receive; and

transmitting subscriber data from the second telecommunications device to the first telecommunications device in accordance with the device information.

² Claims 1-21 have been canceled and claims 26, 28, 34, and 36 have been indicated to be allowable if rewritten in independent form.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Takahashi	US 5,592,546	Jan. 7, 1997
Yablon	WO 99/45687 A1	Sep. 10, 1999

ITU-T Recommendation H.245, *International Telecommunication Union*, XP-002199601, sections 5.2-5.9, September, 1998 ("ITU-T").

Claims 22-24, 29-32, and 37-40 stand rejected under 35 U.S.C. § 103(a) as being obvious over Yablon and ITU-T.

Claims 25, 27, 33, and 35 stand rejected under 35 U.S.C. § 103(a) as being obvious over Yablon, ITU-T, and Takahashi.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R.

§ 41.37(c)(1)(vii).³

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Yablon and ITU-T teach or suggest sending device information from the first telecommunications device to the second telecommunications device

³ Except as will be noted in this opinion, Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

which indicates the type of subscriber data that the first telecommunication device wants to receive.

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a prima facie case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the Applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the Applicant produces rebuttal evidence of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is the Appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d at 988. "To facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

An obviousness rejection can be based on a reference that happens to anticipate the claimed subject matter. *See In re Meyer*, 599 F.2d 1026, 1031 (CCPA 1979). In sustaining a multiple reference rejection under 35 U.S.C. § 103(a), the Board may rely on one reference alone without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966).

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 22-25, 27, 29-33, 35, and 37-40 as being obvious. Reviewing the record before us,

we do not agree. In particular, we find that the Appellants have not shown that the Examiner failed to make a prima facie showing of obviousness. Appellants failed to meet the burden of overcoming that prima facie showing.

§ 103 Rejection - Yablon / ITU-T

Regarding claim 22, Appellants argue that neither Yablon nor ITU-T, alone or in combination, teach or suggest "sending device information from the first telecommunications device to the second telecommunications device which indicates a type of subscriber data that the first telecommunication device wants to receive." (App. Br. 13-14; Reply Br. 2-6.) We do not agree.

Yablon, in Figure 16, teaches a data communication sequence that enables transfer of user-customized caller identification information. (Yablon 10:32-33; Fig. 16.) Step 1 of Figure 16 illustrates a handshake sequence for establishing the protocols for transferring information and the type of information that will be transferred. (Yablon 23:10-15; Fig. 16, steps (a) through (g).) In step (e) of Figure 16, the Primary User's telecommunications device (i.e., the first telecommunications device) sends the query "What do you have for me?" to the Caller's telecommunications device (i.e., the second telecommunications device). In step (f) of Figure 16, the Caller's telecommunications device replies "Phone #, Text, Voice mail, pictures, video, facsimile." Finally, in step (g) of Figure 16, the Primary User's telecommunications device tells the Caller's telecommunications device "I'm not equipped for video. Send the rest with an identifying Field in Front of each." Step 2 of Figure 16 illustrates transmission of the

requested data, with an identifying field for a phone number, text, voice mail, pictures, and facsimile (but not video). (Yablon 23:12-13; Fig. 16.)

Therefore, under a reasonable interpretation of the claim, Yablon teaches sending device information (in step (g) of Fig. 16) from the first telecommunications device (Primary User's telecommunications device) to the second telecommunications device (Caller's telecommunications device) which indicates the type of subscriber data (all data except video -- i.e., phone number, text, voice mail, pictures, and facsimile) that the first telecommunications device wants to receive, as claimed. This interpretation is not inconsistent with the Specification.

As the Specification explains in the BACKGROUND OF THE INVENTION:

Not only is it costly for the caller to transfer large data volumes, it is possible that the telecommunications device of the recipient is not able to process all the caller data that has been transferred. If, for example, the telecommunications device of the recipient either does not have a display facility or does not have a suitable display facility, the device cannot display any image files transferred by the caller that would make transferring any image data to such a recipient inappropriate and superfluous.

(Spec. 4:3-9.) In addition, as the Specification explains in the SUMMARY OF THE INVENTION:

device information that indicates the type of subscriber data that the first telecommunications device is configured to process is sent from the first to the second telecommunications device.

The term "configured" refers to either the first telecommunications device only having a certain range of features (for example, it can play back or send audio files, but does not have a display suitable for showing image files) or the first telecommunications subscriber having for example, set up

his/her telecommunications device so that only certain subscriber data should be received which is indicated to the second telecommunications device using device information. After receiving the first device information, subscriber data is subsequently *transmitted* from the second telecommunications device to the first *in accordance with the first device information*. This simply refers to subscriber data transmitted to the first telecommunications device matching the criteria of the first device information and hence *represents the subscriber data that the first telecommunications subscriber can or wants to receive*.

(Spec. 4:28 to 5:11 (emphasis added).)

Therefore, consistent with the Specification, subscriber data that the first device *wants* to receive may be interpreted as the subscriber data that the first device is *configured* to receive, and subscriber data that the first device is configured to receive includes subscriber data that the first device is capable of receiving. Consequently, we find no error in the Examiner's interpretation (Ans. 4, 12-13) that data the first device *wants* to receive is data the first device is *capable* of receiving. Moreover, as discussed, Yablon teaches that the first device indicates the type of subscriber data it is configured to receive (i.e., all but video data) and thus teaches indicating the type of data it *wants* to receive.

Pointing to Figure 3 of the Specification and the supporting text, Appellants contend that the claim term "wants" must be construed to mean "selectively choose available subscriber data for the device." (App. Br. 13; Reply Br. 2.) We do not agree, and we decline Appellants' invitation to import limitations from the Specification into the claim. However, even under Appellants unduly narrow construction, Yablon teaches sending device information from the first to the second telecommunications device

that the first telecommunications device *wants* to receive because it selectively chooses from the available data for the device by choosing to receive all of the available data it is capable of processing (phone number, text, voice mail, pictures, facsimile) and choosing not to receive available data it is not capable of processing (video).

Appellants also argue that the plain meaning of "want" is "something desired, demanded, or required." (App. Br. 13; Reply Br. 4.) However, under the plain meaning set forth by Appellants, Yablon teaches sending device information from the first to the second telecommunications device that the first telecommunications device *wants* to receive because it desires, demands, or requires to receive all data it is capable of processing (phone number, text, voice mail, pictures, facsimile).

The teachings of ITU-T are cumulative and further buttress the teachings of Yablon. The Examiner correctly found (Ans. 4-5, 12-13) that ITU-T teaches sending device information from the first to the second telecommunications device that the first telecommunications device wants to receive and that it would have been obvious to combine the teachings of Yablon and ITU-T.

Appellants also argue that Yablon does not teach or suggest transmitting subscriber data in accordance with the device information. (App. Br. 14; Reply Br. 6.) We do not agree. Instead, as discussed, step 2 in Figure 16 of Yablon teaches sending subscriber data (phone number, text, voice mail, pictures, video, facsimile) in accordance with the device information communicated in part (g) of step 1.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 22 under 35 U.S.C. § 103(a). Independent

claims 30, 38, and 40 were argued on the same basis as independent claim 22 (App. Br. 13; Reply Br. 2), and we find that Appellants have failed to show error in the rejection of claims 30, 38, and 40 for the same reasons discussed with respect to claim 22. Dependent claims 23-24, 29, 31, 32, 37, and 39 were not argued separately (App. Br. 14-15; Reply Br. 6-7), and fall together with claims 22, 30, and 38, from which they ultimately depend.

§ 103 Rejection - Yablon / ITU-T / Takahashi

Dependent claims 25, 27, 33, and 35 were not argued separately (App. Br. 14-15; Reply Br. 6-7), and we find that Appellants have failed to show error in the rejection of claims 25, 27, 33, and 35 for the same reasons discussed with respect to independent claims 22 and 30, from which they ultimately depend.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 22-25, 27, 29-33, 35, and 37-40 for obviousness under 35 U.S.C. § 103.

DECISION

The rejection of claims 22-25, 27, 29-33, 35, and 37-40 for obviousness under 35 U.S.C. § 103 is affirmed.

Appeal 2008-0739
Application 10/517,935

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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